

REMARKS

Status of the Application and the Present Response

Claims 1-62 were pending in the application, with claims 7-62 being withdrawn from consideration as directed to non-elected inventions. In addition, claim 2 was also withdrawn from consideration by the Examiner. However, as detailed below, Applicants believe the withdrawal is erroneous.

With the instant response, Applicants request entry of the enclosed sequence listing into the subject specification. In addition, Applicants have amended page 33 of the specification to remove a blank space and to correct a typographical error. Page 36 is amended to insert sequence numbering to the PCR primer sequences. Applicants have also amended Table 4 on page 43 in order to insert sequence numbering. In addition, the amended table eliminates redundant listing of one gene, HT2352. Further, the original table inadvertently named AF071202 (MOAT-B; SEQ ID NO: 14) "MRP4" which is the gene name of U83660 (SEQ ID NO: 16). This typographical error is also corrected with entry of the instant response.

Applicants request entry of amendments to claims 1-3. These claims are amended to insert sequence numbering. The claims are amended to delete recitation of tables 2 and 3 because genes listed in tables 2 and 3 are all included in the genes listed in table 4.

The amendments made herein do not introduce new matter. Entry of these amendments is respectfully requested. Unless otherwise indicated, the amendments have been made to improve clarity or to expedite prosecution of the subject application, and should not be construed as acquiescence of any ground of rejections.

Referring to the paragraph numbering in the office action (when applicable), the following remarks address issues raised in the office action.

Submission of Sequence Listing

Applicants submit herewith a paper copy of a Sequence Listing (pages 1-190) and a floppy disk which contains an initial computer readable form (CRF) copy of the Sequence Listing, in compliance with the requirements of 37 CFR 1.821-1.825. The paper

copy of the sequence information has been printed from the floppy disk. The information contained in the computer readable disk was prepared through the use of the software program "PatentIn" and is identical to that of the paper copy. Entry the Sequence Listing into the subject patent application is respectfully requested, in accordance with the requirements of 37 CFR 1.821-1.825.

Withdrawal of Claim 2

1. Claim 2 was withdrawn in the instant office action on the basis that "Applicant elected only the single gene." Applicants respectfully disagree because the rationale for the withdrawal is plainly incorrect. It should be noted that Claim 1 recites "detecting a level of expression of at least one gene identified in Table 4," which means the claimed method can detect expression of 1, 2, 3, or more genes (up to all the 49 genes listed in Table 4). Applicants have elected one species, hepsin, for examination in response to the species election requirement. The practical consequence to Applicants' species election is that, for examination purpose, hepsin must be one of the "at least one gene." In other words, only claims that do not recite or encompass hepsin can be properly withdrawn from consideration because such claims would not read on the elected species. By no means does it indicate that claims directed to detecting expression of more than one gene would not read on the elected species. Claim 2 clearly reads on the elected species because it does not exclude hepsin by reciting "expression of at least two genes."

It also does not make any sense to restrict out claims that recite detection of expression of more than one gene. This is because the transition word "comprising" (as opposed to "consisting of") of the claims manifest the open-ended scope of the claim language (see MPEP 2111.03). A claim reciting detecting expression of one gene does not exclude detection of expression of additional genes. Further, it is readily apparent that if a claim directed to detecting expression of one gene is patentable, then (dependent) claims which include detection of the expression of additional genes would be automatically patentable. No additional search of prior art will be incurred to examining such (dependent) claims together with the independent claim. For all these reasons, Applicants submit that Claim 2 should be included in the elected claims for examination purpose.

Objection to the Specification

3. It was stated in the Office Action that Applicants need to amend the specification to reflect the status of the parent applications. In response, Applicants note that, as described in the Specification, the instant application claims priority to two US provisional patent applications (60/263,461 and 60/301,639), with their respective filing dates indicated in the specification. Since provisional patent applications automatically expire one year from their filing dates, their status should be readily apparent (as opposed to nonprovisional patent applications). Applicants respectfully seek clarification from the Examiner should the instant objection be maintained.

4. It was alleged that the subject specification has essential material incorporated by reference. As suggested by the Examiner, Applicants have herein amended the specification by inserting the nucleotide sequences of the genes recited in the claims and the accompanying sequence listing. Applicants' below undersigned representative further declare that the sequence listing contains sequence information that is the same as that was incorporated by reference in the subject specification.

5. The Office Action also made objection the specification as allegedly containing an embedded hyperlink and/or other form of browser-executable code. Upon reviewing the specification as filed, Applicant could not find any executable hyperlink or other browser-executable code in the specification. Applicant notes that there are only non-active URL sites in the text of the specification. However, such are not "embedded hyperlinks" prohibited by the MPEP. Rather, what is prohibited by the MPEP are active browser-executable links. The MPEP specifically states that "examiners should not object to these hyperlinks" that are not intended to be active by applicants (see, e.g., § 608.01 of the MPEP, 8th ed., August 2001, at page 600-60, the paragraph bridging the left and right columns). If this objection is maintained, clarification is respectfully requested.

6. The subject specification was objected to because of alleged failure to comply with the sequence listing requirement under 37 CFR 1.821. Applicants have herein provided a sequence listing in accordance with the sequence rule. The subject specification has been accordingly amended.

7. Objection was further made to the specification because of blank space in the specification on page 33. Applicants have herein amended the specification by removing the noted blank space in the specification.

Rejection under 35 U.S.C. § 112

8-10. Claims 1 and 3-6 were rejected as allegedly being indefinite. The ground for these rejections was that the specification disclosed only the accession numbers of the genes recited in the claims, but not their full sequences. For the same reason, the claims were also rejected as allegedly failing to comply with the written description requirement and lacking enablement. Applicants respectfully disagree with the reasoning underlying the rejections. Nevertheless, in the interest of expedited prosecution, Applicants have herein amended the specification by inserting the nucleotide sequences of the genes recited in the claims. Accordingly, Applicants respectfully request that these rejections be withdrawn.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1539.

Respectfully submitted,



Hugh Wang, Ph.D.
Reg. No. 47,163

Customer No.: 29490

GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION
10675 John Jay Hopkins Drive, Room E227
San Diego, CA 92121
Tel: (858) 812-1539
Fax: (858) 812-1981